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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,997	12/15/2003	Jon E. Ness	10181.210-US	6691

25908 7590 05/25/2006

NOVOZYMES NORTH AMERICA, INC.  
500 FIFTH AVENUE  
SUITE 1600  
NEW YORK, NY 10110

EXAMINER

MOORE, WILLIAM W

ART UNIT	PAPER NUMBER
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1656

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/736,997

Applicant(s)

NESS ET AL.

Examiner

William W. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 124-161 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 124-126, 131, 132 and 161 is/are rejected.
- 7) ☒ Claim(s) 127-130 and 133-160 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20031215</u> . | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

*Response to Amendment*

Applicant's Response filed 27 February 2006 cancels claims 1-23 and provides the new claims 124-161 that correspond to the invention that Applicant had elected as commemorated at page 2 of the communication mailed 25 August 2005. The new claims avoid all but one of the rejections of record over the prior art of record and permit the withdrawal of the rejection of record of claims herein under the first paragraph of 35 U.S.C. § 112 in view of the disclosure at page 29, lines 24 and 25, and several species of modified catalytic domains sharing at least 90% identity with SEQ ID NO:134 herein.

*Information Disclosure Statement*

Applicant's Information Disclosure Statement [IDS] filed with the application on 15 December 2003 but not previously acknowledged is acknowledged herewith and executed copies of its Forms PTO/SB/08A accompany this communication.

*Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 124-126, 131, 132, and 161 are rejected, essentially for reasons of record under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 20-23 of the commonly-assigned U.S. Patent No. 6,777,218. Applicant indicates that a Terminal Disclaimer may be filed upon indication

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of allowable subject matter but the rejection must be maintained unless and until a Terminal Disclaimer is provided. Although the conflicting claims are not identical, they are not patentably distinct from each other because the catalytic domains, subtilase polypeptides, and detergent compositions of claims 124-126, 131, 132, and 161 herein share at least 96% identity with the catalytic domains, subtilase polypeptides, and detergent compositions of the patented claims 1-7 and 20-23.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 124-126, 131, 132, and 161 are rejected, essentially for reasons of record, under 35 U.S.C. § 102(e) as being anticipated by Mikkelsen et al., US 6,777,218, of record.

Applicant's arguments filed 27 February 2006 have been fully considered but they are not persuasive. Applicant argues at the close of the Response that "Mikkelsen et al. is not prior art against the present application" because "[t]he subject matter described in Mikkelsen et al. and Applicant's invention claimed herein were developed in the same collaboration and project by Maxygen and Novozymes." Mikkelsen et al. is, however, the prior disclosure of an inventive entity that differs from the inventors named herein and disclose the amino acid sequence of a *Bacillus subtilisin* having the amino acid sequence set forth in their SEQ ID NO:2, the catalytic domain of which shares 96% sequence identity with the catalytic domain sequence set forth in SEQ ID NO:134, and a detergent composition comprising same. Applicant cites no statutory exception that will permit removal of the disclosure of Mikkelsen et al. as prior art to a claimed invention, thus the rejection of record is maintained.

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*Conclusion*

Claims 127-130 and 133-160 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is 571.272.0933 and whose FAX number is 571.273.0933. The examiner can normally be reached Monday through Friday between 9:00AM and 5:30PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisory Primary Examiner, Ms. Kathleen Kerr, can be reached at 571.272.0931. The official FAX number for all communications for the organization where this application or proceeding is assigned is 571.273.8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571.272.1600.

William W. Moore  
5 May 2006

  
NASHAAT T. NASHED PH.D.  
PRIMARY EXAMINER